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IN THE

# Supreme Court of the United States

October Term, 1974

No. 74-15

UNIVERSAL ATHLETIC SALES CO.,
*Petitioner,*

*v.*

DONALD E. PINCHOCK, *et al.*,
*Respondents.*

## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

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## PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

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Petitioner respectfully prays that a writ of certiorari issue to review the judgment and opinion of the United States Court of Appeals for the Third Circuit in this case.

### OPINIONS BELOW

The opinion of the Court of Appeals, which is reported at 511 F.2d 904 (1975), is set forth in the Appendix at pp. 1-13 . The order of the Court of Appeals denying rehearing is set forth in the

Appendix at p. 15. The opinions of the United States District Court for the Western District of Pennsylvania, which are reported at 340 F. Supp. 899 (1972), at 376 F. Supp. 514 (1974), and (unofficially) at 182 U.S.P.Q. 278 (1974), are set forth in the Appendix at pp. 16-45.

## JURISDICTION

The judgment of the Court of Appeals was entered on February 28, 1975. (App. 14)[1]. Petitioner's petition to the Court of Appeals for rehearing in banc was denied on April 7, 1975. (App. 15). The jurisdiction of this Court is invoked under 28 U.S.C. §1254(1).

## QUESTIONS PRESENTED

1. Whether the Court of Appeals decided this case contrary to *Fountain v. Filson,* 336 U.S. 681 (1949), by vacating summary judgment of copyright infringement granted by the District Court in petitioner's favor, no cross motion for summary judgment having been brought by respondents, and entering judgment against petitioner on the basis of findings on new factual issues made by the appellate court on a limited record, which findings were material to the grounds for its decision against petitioner's claim but which petitioner had no opportunity to dispute in the District Court or on appeal?

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1. References to the Appendix annexed hereto are designated as "App." with a page number.

2. Whether the Court of Appeals can act to defeat the summary judgment procedure established in Rule 56, Fed.R.Civ.P., thereby foreclosing trial of petitioner's claim for copyright infringement, through the expedient of entering judgment against petitioner on the sole basis of the appellate court's comparison of the actual accused and copyrighted works, although neither of the works actually compared was designated in the limited record on appeal and in spite of the fact that petitioner had no opportunity whatsoever to dispute the appellate court's own factual determinations regarding the history, originality and substance of the works because such issues were not considered in the District Court or in designating the record on appeal?

## RULE OF CIVIL PROCEDURE INVOLVED

*RULE 56. SUMMARY JUDGMENT*

"(a) For Claimant. A party seeking to recover upon a claim ... may ... move with or without supporting affidavits for a summary judgment in his favor upon all or any part thereof."

* * * *

"(c) Motion and Proceedings Thereon. ... The judgment sought shall be rendered forthwith if the pleadings, depositions, answers to interrogatories, and admissions on file, together with the affidavits, if any, show that there is no genuine issue as to any material fact and that the moving party is entitled to a judgment as a matter of law.

A summary judgment, interlocutory in character, may be rendered on the issue of liability alone although there is a genuine issue as to the amount of damages."

## STATEMENT OF THE CASE

Petitioner is Universal Athletic Sales Co. ("Universal"), a manufacturer of multi-station gymnasium exercising machines, some stations of which involve the use of weights. The copyrighted works are illustrated instructional materials designed to be used with petitioner's machines. The works consist of two successive versions of a wall chart and a "Coaches' Training Manual", each of which employs simplified human figure sketches to illustrate the correct techniques for performing selected exercises at each machine station.

In the wall chart, selected sketches, accompanied by only minimal descriptive text, are arranged in concise groupings for each machine station to serve as a quick, convenient visual reference for users of the machines. Petitioner's Training Manual presents each of these same sketches but provides more complete descriptive text, and also contains extensive text materials dealing with general weight training and personal physical conditioning programs. Copyrights on both the wall chart and the manual were registered as books under subsection (a) of Section 5 of the Copyright Act (17 U.S.C.).

Respondents Donald E. Pinchock and S. David Brodsky were two of the three founders[2] of respondent Super Athletics Corporation ("Super Athletics"). Respondent Wes Hudson ("Hudson") was hired by Super Athletics for the express purpose of producing the accused work. Super Athletics was formed to manufacture and sell multi-station gymnasium exercising machines[3] in competition with Universal.

Respondents' accused work is likewise a wall chart prepared for use with their multi-station gymnasium exercising machines. As in petitioner's chart, simplified human figure sketches are grouped in the accused chart to illustrate the performance of selected exercises at each machine station. However, unlike petitioner's charts -- but *like* its manual, respondents' accused chart has considerable descriptive text accompanying each sketch, along with other extensive text materials and diagrams dealing with general weight-training and personal physical conditioning programs. Petitioner thus alleged in its complaint that the accused wall chart infringed not only petitioner's copyrighted wall charts but also its copyrighted manual.

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2. The third founder, Larry Salkeld ("Salkeld"), was a defendant in the District Court but did not join in the appeal from the entry of summary judgment against all defendants.

3. One station of the Super Athletics machine, the chest press station, is the subject matter of a patent infringement action by Universal against the respondents (except Hudson).

Shortly after bringing suit[4] against respondents, petitioner moved the District Court for a preliminary injunction against further distribution of the accused work. The motion was based upon a detailed comparison of the selection, grouping and placement of the human figure sketches in the respective wall charts and also upon an analysis of the similarities between the other descriptive materials found both in respondents' accused wall chart and in petitioner's copyrighted manual. Respondents opposed the motion by denying both access to the copyrighted works and copying thereof.

The District Court granted a preliminary injunction against respondents and Salkeld after finding that they had "access" to the copyrighted works and that substantial similarity existed between the accused wall chart and both petitioner's wall chart and its manual. In making its specific findings on the question of substantial similarity, the District Court applied the test of whether "an average lay observer would find a substantial similarity in ... recognizing the copy to be an appropriation of the copyrighted work". (App. 18).

Later, petitioner brought a motion in the District Court to have certain respondents held in civil contempt for having continued the distribution of their accused wall charts in violation of the preliminary injunction. After hearing, those respondents were held to have been in civil contempt and petitioner was awarded substantial damages and attorney fees.

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4. Jurisdiction of the action in the District Court was based on 28 U.S.C. §1338(a).

In subsequent discovery, respondents admitted (i) the ownership and validity of petitioner's copyrights in both its charts and its manual and (ii) that various parts of the accused wall chart had been copied from the copyrighted charts and manual. Specifically, respondent Hudson testified on deposition that he had drawn precise freehand outlines directly from the human figure sketches on petitioner's copyrighted chart for the express purpose of making sure that respondents' chart "covered everything, let's say, that Universal's chart had on theirs". Similarly, Hudson's co-defendant Salkeld admitted having prepared the textual materials on respondents' chart by direct paraphrasing from the corresponding portions in petitioner's copyrighted manual.

On the strength of these admissions believed to be dispositive of the case, petitioner moved for summary judgment of copyright infringement. Respondents opposed the motion,[5] contending that both the credibility of Salkeld's admissions and the degree of "substantial similarity" needed to show an "improper appropriation" constituted issues of fact remaining to be resolved at trial. Petitioner urged, however, that, because respondent Hudson's admissions of direct and wholesale copying of the figure sketches from the copyrighted chart were undisputed, copyright infringement was established as a matter of law, notwithstanding any dispute as to other similarities.

The District Court agreed with petitioner and entered summary judgment of copyright infringement (App. 39-45); the order included a permanent injunction and set a hearing date for an accounting on profits and damages. In so ruling, the

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5. But did not bring a cross motion for summary judgment.

District Court expressly incorporated by reference its previous opinion and order granting the preliminary injunction (App. 40), thus adopting its prior findings regarding "substantial similarity" based on the "appropriation of the copyrighted works" test. Before the District Court could enter final judgment on the accounting, respondents filed their Notice of Appeal seeking review of both the final judgment for civil contempt and the interlocutory summary judgment order.

The record designated by the parties on appeal consisted for the most part of certain exhibits offered by petitioner in support of its motions and only those selected portions of the deposition transcripts, interrogatory answers and requests for admissions that were pertinent to the findings of the District Court. Significantly, the designated record on appeal did not contain the actual accused and copyrighted works; instead respondents provided only the reduced black and white photostatic copies of the parties' wall charts that had been attached to petitioner's complaint. Nor did the record on appeal contain other extensive deposition testimony, discovery materials and evidence pertinent to further aspects of the infringement issue, such as the true history, substance and originality of the works.

Following the submission of appeal briefs, oral argument on the existing record and issues was heard by the Court of Appeals on January 9, 1975. Only afterwards was the record on appeal supplemented at the request of the Court of Appeals by delivery of the original versions of the actual charts to the Clerk of the Court of Appeals on January 17, 1975.

On February 28, 1975, the Court of Appeals rendered a decision against petitioner that not only reversed and vacated the summary judgment of copyright infringement, together with the civil contempt judgment, but also entered final judgment in favor of respondents. The decision was founded on the Appellate Court's own observation of the actual charts which the Court itself had undertaken to obtain. Based on these observations and finding itself "in as good a position to determine the question as is the district court", the Court of Appeals concluded that no infringement could be found. (App. 6).

Among the factual determinations needed by the Court to reach its conclusion were:

(i) The relative importance of various similarities and dissimilarities between the works including color, size, drawing style, shape and emphasis of detail (App. 10-11);

(ii) The degree of structural similarity between the parties' respective machines in relationship to the body positions involved in their operation (App. 11);

(iii) Petitioner's "primary concern", "feeling of resentment", and "foremost consideration" for seeking protection of its copyrights (App. 7); and

(iv) The degree of creativity involved in producing the copyrighted works, the substance of the ideas being expressed therein, and the limited modes for their expression. (App. 7-8, 11).

Petitioner's timely petition for rehearing by the court in banc was denied without comment on April 7, 1975. (App. 15).

## REASONS FOR GRANTING THE WRIT

### The decision below conflicts directly with a *per curiam* decision of this Court

The decision of this Court in *Fountain v. Filson,* 336 U.S. 681 (1949) *per curiam*, prohibits an appellate court from depriving an appellee of an opportunity to dispute the facts material to a defense against his claim by summarily entering judgment against him. In this case, petitioner moved for and was awarded summary judgment in the District Court based upon respondents' admissions of (i) ownership of copyrights by petitioner and (ii) deliberate direct copying of petitioner's copyrighted works. No cross motion for summary judgment was filed by respondents.

The Court of Appeals vacated that summary judgment and, on the basis of its own erroneous and unsupported factual assumptions, concluded that there was no copyright infringement; whereupon, the Court of Appeals entered judgment against petitioner. The decision of the Court of Appeals amounts to a foreboding warning to a plaintiff in a copyright infringement action that he may bring a motion for summary judgment only at the risk of being denied a trial on the merits should his legal theory on the motion be wrong.

In *Fountain v. Filson, supra,* Mr. and Mrs. Filson brought suit against Mr. and Mrs. Fountain claiming that the title to certain realty had been acquired by the Fountains

subject to a resulting trust in favor of the Filsons. The Fountains' motion for summary judgment, brought on the theory that the applicable law would not permit imposition of a resulting trust under the circumstances disclosed in the existing record, was granted by the trial court. On appeal, the circuit court agreed that no resulting trust could arise under applicable law; nevertheless, the appellate court, after examining the limited record on appeal, concluded that summary judgment was erroneously granted because the record on appeal showed the existence of a personal obligation even in the absence of a resulting trust. Whereupon, the appellate court remanded the case to the lower court with instructions to enter a money judgment in favor of the Filsons.

This Court granted certiorari and reversed. In a *per curiam* opinion, this Court distinguished the case from a case where cross motions for summary judgment are filed and said:

> "For here the order was made on appeal on a new issue as to which the opposite party had no opportunity to present a defense before the trial court."
> [336 U.S. at 683]

The Court's *ratio decidendi* in *Fountain v. Filson* squarely applies to the facts of this case:

> "There was no occasion in the trial court for Mrs. Fountain to dispute the facts material to a claim that a personal obligation existed, since the only claim considered by that court on her motion for summary judgment was a resulting trust. When the Court of Appeals concluded that the trial court should have considered a claim for personal judgment it was error for it to deprive Mrs. Fountain of an opportunity to dispute the facts material to that claim by ordering summary judgment against her."
> [336 U.S. at 683]

Likewise, petitioner here had no occasion in the trial court to dispute the facts material to the issue of whether "such a quantum of substantial similarity existed as to constitute an infringement". (App. 6). The only legal theory (i) advanced by petitioner in its motion for summary judgment and (ii) considered by the District Court in granting that motion was that copyright infringement was made out on the basis of respondents' admissions of ownership of the copyrights and respondents' direct copying thereof. Petitioner believed this theory to be well-founded for it was in accord with the widely-accepted views of M. Nimmer[6]:

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6. See this Court's opinion in *Twentieth Century Music Corp. v. Aiken*, (No. 74-452).

> "Plaintiff's proof, reduced to its most fundamental terms, may be said to consist of two elements *ownership*[7] by plaintiff, and *copying* by the defendant."
> [NIMMER ON COPYRIGHT, §141 at p. 611]

In fact, petitioner urged both the District Court and the Court of Appeals that the availability of direct evidence of copying in this case should be dispositive of copyright infringement; i.e. that it is unnecessary to resort to the inferential tests of access and substantial similarity where "the plaintiff has available a witness to the act of copying"; see NIMMER §141.2 at p. 613.

The District Court accepted this theory but the Court of Appeals, while attaching little weight to respondents' admissions, concluded that an additional test -- "that of substantial similarity in the sense of an appropriation of the original work" must be met to establish infringement. (App. 5 ). The Court of Appeals observed *incorrectly* that the lower court made no specific finding on the test[8] and then proceeded to compare the actual copyrighted and accused works. To make matters worse, this comparison could not have been made until after briefs were submitted and oral argument was had because the actual works

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7. Emphasis ours throughout unless otherwise noted.

8. The District Court's opinion on the preliminary injunction proceeding states: "[M]uch of defendants' work was copied from plaintiff's copyrighted work". (App. 19 ).

were not in the record designated on appeal; *supra*, p. 8.

Nevertheless, even if the Court of Appeals had been correct in finding that the District Court had erroneously failed to consider the issue of "substantial similarity in the sense of an appropriation", the Court of Appeals should have provided petitioner with an opportunity to meet that additional test and dispute the facts found to be material to that issue by remanding the case to the trial court. Instead, the Court of Appeals, relying on a limited record on appeal, made extensive findings of fact material to the issue of substantial similarity (i.e. relative to an unlawful appropriation) and concluded that there was no infringement. This procedure clearly is not sanctioned by *Fountain v. Filson.*

The decision below thwarts the summary judgment procedure established by Civil Rule 56

Rule 56(c), Fed.R.Civ.P., clearly prevents the entry of judgment in summary fashion if there exists a "genuine issue as to any material fact"; and Professor Moore, in his Treatise, states:

> "The courts are in entire agreement that the moving party for summary judgment has the burden of showing the *absence* of any

> genuine issue as to *all* the material facts, which, under applicable principles of substantive law, entitle him to judgment as a matter of law."
> [footnotes omitted]
> 6 MOORE, FEDERAL PRACTICE §56.15[3]

The Court of Appeals' decision effectively relieved respondents of this burden which they surely would have had if they had brought a cross motion for summary judgment in the District Court. Plainly, the decision thwarts the purpose of Rule 56 and encourages the resolution of factual issues in the Courts of Appeal. As to the latter point, the Court of Appeals purports to follow the Second Circuit decision in *Arnstein v. Porter,* 154 F.2d 464 (2nd Cir. 1946) with respect to the substantive law of copyrights, yet completely ignores the procedural warning laid down in that case (154 F.2d at 474):

> "The avowed purpose of those who sponsored the summary judgment practice was to eliminate needless trials where by affidavits it could be shown beyond possible question that the facts were not actually in dispute. In the attempt to apply that reform -- to avoid what is alleged to be a needless trial in a trial court -- *we should not conduct a trial in this court.*"

From a mere reading of the *ad hoc* factual determinations made by the Court of Appeals in summarily disposing of petitioner's claim (*supra,* p. 9);

it is obvious that the Court of Appeals sought to undertake the fact-finding function of the District Court in clear breach of the admonition in *Arnstein*.

## CONCLUSION

For the foregoing reasons, this Court should issue a writ of certiorari to review the opinion and judgment of the Court of Appeals.

Respectfully submitted,

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# APPENDIX

## Opinion of the United States Court of Appeals

UNITED STATES COURT OF APPEALS
For The Third Circuit

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No. 74-1456

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UNIVERSAL ATHLETIC SALES CO.,
a corporation

v.

LARRY SALKELD, DONALD E. PINCHOCK, S. DAVID BRODSKY, individuals, d/b/a SUPER ATHLETICS CORPORATION; WES HUDSON, an individual; and SUPER ATHLETICS CORPORATION, a corporation.

DONALD E. PINCHOCK, S. DAVID BRODSKY, individuals, d/b/a SUPER ATHLETICS CORPORATION; WES HUDSON, an individual; and SUPER ATHLETICS CORPORATION, a corporation,

*Appellants.*

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APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

(D.C. Civil No. 71-1113)

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Argued January 9, 1975

Before ALDISERT, WEIS and GARTH, *Circuit Judges*.

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OPINION OF THE COURT

(Filed February 28, 1975)

Weis, *Circuit Judge.*

A chart picturing approved methods to develop physical prowess on a weight-lifting machine leads us to an intellectual exercise in the copyright arena. While weight lifting has the virtue of a rigidly disciplined routine, the copyright law

offers, in the main, elusive and nebulous abstractions. And so, while we conclude that the district court erred in finding infringement, we do so without the certainty and satisfaction that accompanies the execution of a perfect "press".

A basic principle, easy to articulate but difficult to apply, is that the expression of an idea may be protected by copyright but the idea itself cannot. The case at bar presents us with the issue whether the defendants' expression of a concept, basic to the use of both its product and the plaintiff's, was so substantially similar as to amount to an infringement.

The individual defendants formed the Super Athletics Corporation in 1971 to manufacture and distribute a multi-station exercise machine designed so that its use brings about the body motions involved in weight lifting. To assist its customers, the defendants prepared a wall chart which utilized sketches, sometimes called "stick figures" to depict certain exercises performed on the machine together with textual material to explain the specific exercises and weight lifting in general.

The plaintiff, Universal Athletic Sales, is a manufacturer of a similar machine, and in 1969 and 1970 it copyrighted an exercise wall chart which it furnished its customers along with a Coaches' Training Manual. Alleging that the defendants had infringed its copyrights, the plaintiff moved for and was granted a preliminary injunction against further circulation of the defendants' chart on

April 13, 1972.[1] The order specified that the injunction would issue upon the posting of a $5,000 bond by plaintiff Universal. This condition was not satisfied until April 21, 1972, and in the interim a number of the defendants' charts were distributed to customers and prospective buyers. At least one additional mailing occurred after the bond had been posted. After a hearing, the district court found the defendants in civil contempt for all the acts of distribution after April 13, 1972 and assessed damages and counsel fees.

The plaintiff then moved for summary judgment, relying upon portions of discovery depositions of various of the defendants, parts of the testimony taken during the contempt proceeding, and an analysis of similarities between the two charts. After argument, the district court filed an opinion granting summary judgment. This appeal was taken from that judgment as well as from the finding of civil contempt.

To establish a copyright infringement, the holder must first prove that the defendant has copied the protected work and, second, that there is a substantial similarity between the two works. The criterion for the latter requirement

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1. The opinion of the district court is reported at 340 F.Supp. 899 (W.D.Pa. 1972). Although the complaint alleged that certain weight-training information on the accused chart had been plagiarized from the original manual, the district judge did not decide the question, and plaintiff did not appeal from the failure to decide it. We, therefore, are not faced with an issue of the wall chart's comprehensive nonliteral similarity to the manual.

is whether an ordinary lay observer would detect a substantial similarity between the works. *Ideal Toy Corporation v. Fab-Lu Ltd.*, 360 F.2d 1021 (2d Cir. 1966). Phrased in an alternative fashion, it must be shown that copying went so far as to constitute improper appropriation, the test being the response of the ordinary lay person. *Arnstein v. Porter,* 154 F.2d 464 (2d Cir. 1946). *See also* NIMMER ON COPYRIGHT §143.53 (1973 ed.).

As to the first issue, that of copying, the district court found that, although there was a dispute as to whether the stick figures in the plaintiff's chart were traced by one Hudson, an employee of the defendants, or were merely copied freehand, the distinction (*i.e.* between copying and tracing) was not material.[2] Having concluded that there was copying, the court found for the plaintiff.

The court made no specific finding, however, that would meet the second test--that of substantial similarity in the sense of an appropriation of the original work. It did, however, refer to the findings made when the preliminary injunction was issued. At that time, the district judge determined that there was "substantial similarity" between the two charts. After applying the test of whether an average lay observer would so find, the court proceeded to analyze in detail various stick figures, comparing the position of arms, legs, etc. This "dissection" of the two works is an

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2. Hudson was the artist who prepared the chart under defendant Salkeld's supervision. In his deposition, he stated that the Universal chart was one of his source materials and that he tried to make his work dissimilar to the Universal version.

approved way of pinpointing similarities in a search to establish the facts of copying and of access to the copyrighted material where such proof is otherwise lacking.

But, substantial similarity to show that the original work has been copied is not the same as substantial similarity to prove infringement. As the *Arnstein* case points out, dissection and expert testimony in the former setting are proper but are irrelevant when the issue turns to unlawful appropriation. While "[r]ose is a rose is a rose is a rose," substantial similarity is not always substantial similarity.

We conclude that the entry of summary judgment in favor of the plaintiff must be vacated because the district court did not find that such a quantum of substantial similarity existed as to constitute an infringement. Ordinarily, a remand to the district court would be required. However, based on an observation of the charts which are in the record, we have concluded that there was no infringement. Since no question of credibility is involved in this phase of the case, the Court of Appeals is in as good a position to determine the question as is the district court. *Puddu v. Buonamici Statuary, Inc.*, 450 F.2d 401 (2d Cir. 1971); *Concord Fabrics Inc. v. Marcus Brothers Textile Corp.*, 409 F.2d 1315 (2d Cir. 1969); *Millworth Converting Corp. v. Slifka*, 276 F.2d 443 (2d Cir. 1960). *See* NIMMER ON COPYRIGHT §140.

A review of copyright infringement decisions confirms the observation that most cases are decided on an *ad hoc* basis. Judge Hand aptly expressed the state of the law when he said that

"[t]he test for infringement of a copyright is of necessity vague," *Peter Pan Fabrics, Inc. v. Martin Weiner Corp.*, 274 F.2d 487, 489 (2d Cir. 1960), and that "... the line, where-ever [sic] it is drawn, will seem arbitrary ...," *Nichols v. Universal Pictures Corp.*, 45 F.2d 119 (2d Cir. 1930), *cert. denied* 282 U.S. 902 (1931). It is necessary, then, that we analyze some of the factors which must enter into a consideration of whether there has been an appropriation, *i.e.*, whether there has been a taking of the independent work of the copyright owner which is entitled to the statutory protection.

From the record in this case, it is obvious that plaintiff's primary concern was not with defendants' use of the stick figures but with the ideas that they conveyed. Thus, its expert on damages testified to the cost of obtaining the medical and physiological bases for the various exercises which were illustrated as well as to the expense incurred in sending experts to the customers to convey the information to them via a live demonstration. Underlying Universal's claim of infringement was a feeling of resentment that the defendants had utilized knowledge which had been secured without their own independent research. In short, it was the protection of the idea that was the foremost consideration of the plaintiff. But, copyright does not protect ideas--only expressions.

It is true that originality is not a prerequisite of copyright, and even a modicum of creativity may suffice for a work to be protected. Nevertheless, between the extremes of conceded creativity and independent efforts amounting to no more than the trivial, the test of appropriation necessarily varies. In this context, there is some philosophical parallel with the standards applicable to

the grant of copyright in the first instance.[3]

In discussing copyright eligibility, Nimmer writes: "However, it must be recalled that even most commonplace and banal results of independent effort may command copyright protection provided such independent effort is quantitatively more than minimal ... It appears, then, that there is a reciprocal relationship between creativity and independent effort. The smaller the effort (e.g. two words) the greater must be the degree of creativity in order to claim copyright protection." NIMMER ON COPYRIGHT §10.2.

Other factors which should be considered are the nature of the protected material and the setting in which it appears. Nimmer suggests that "[W]ith respect to commercial documents, for example, the similarity probably must be more extensive than in the case of more artistic works in order to justify a finding of substantial similarity." *Id.* §143.2 at 631. He follows with a footnote observation that "If the quantum of originality is very modest, it may be that 'more than a "substantial similarity" should be necessary for a finding of infringement,' *Thomas Wilson & Co. v. Irving J. Dorfman Co.*, 268 F.Supp. 711 (S.D.N.Y. 1967)." *Id.* §143.2 n.107 (Supp. 1974).

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3. We do not overlook the observation in Puddu v. Buonamici Statuary, Inc., 450 F.2d at 402, that "The tests for eligibility for copyright and avoidance of infringement are not the same.

In *Gaye v. Gillis,* 167 F.Supp. 416, 418 (D. Mass. 1958), the court said:

> "A copyright does not cover an idea or a system of doing business but only the particular mode of expression of the idea embodied in the copyrighted material. The public is free to use the idea or method of doing business and hence, while the copyrighted description of the idea may not be slavishly copied, the copyright is not infringed by an expression of the idea which is substantially similar where such similarity is necessary because the idea or system being described is the same."

Having reviewed the law, we not put it aside while we record our impressions as they would appear to a layman viewing the two charts side by side. In so doing, we concentrate upon the gross features rather than an examination of minutiae.

It is difficult to explain all the points of similarity and dissimilarity between the two charts without going into great detail. We give only some of the more obvious ones to indicate the general nature of our reaction to viewing the two. Since there are seldom, if ever, cases dealing with the same materials in litigation of this nature, we do not believe that an extended description would be helpful as precedent. We can only paraphrase the language of Judge Hand in *Nichols v. Universal Pictures Corp., supra* at 123. The more the court is led into the finer points of the

drawings, the less likely it is to stand upon the firmer, if more naive, ground of its considered impressions after its own perusal.[4]

The most obvious differences are in color and arrangement. The accused chart is blue and white, and its horizontal dimensions are greater than its vertical ones. The plaintiff's chart is red and white and is longer vertically than horizontally. The figures in the defendants' chart are simple, are outlined in blue, contains no facial features, and are rugged in appearance. Each sketch showing an exercise position is accompanied by textual material describing the correct procedure. On the other hand, the plaintiff's chart has figures which show some minimal facial features, are outlined in black, and were drawn with more delicate strokes. In only a few instances is there descriptive material beside the figures.

The figures in the accused chart show only one body position per sketch. Plaintiff's chart uses figures with superimposed red lines over the basic position to indicate the changing posture of the body as the exercise proceeds.

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4. Nimmer points out that "It is entirely immaterial that in many respects plaintiff's and defendant's works are dissimilar if in other respects similarity as to a substantial element of plaintiff's work can be shown ... Of course, if the points of dissimilarity not only exceed the points of similarity, but indicate that the remaining points of similarity are (within the context of plaintiff's work) of minimal importance either quantitatively or qualitatively, then no infringement results." §143.2 at 632.

Defendants' chart has a rather extensive text at the bottom of the chart dealing with general weight-training information, personal weight-training programs, and Super Gym specifications as well as diagrams of two human figures showing the major muscles. None of this material appears on the plaintiff's chart.

In some of the plaintiff's sketches the exercising figure wears a T-shirt and trunks--in others only trunks. In the defendants' chart the abdominal and chest muscles in the figures are emphasized, and only trunks are worn.[5]

The only real similarities are the use of stick figures in both charts and the corresponding positions of the figures for each exercise. The use of stick figures involves only that minimal amount of creativity discussed earlier, and the position of the stick figures must necessarily be similar because both express the same idea. The plaintiff and defendant machines are so similar in operation that the body positions must be similar.[6] In short, a lay observer could not find such a substantial similarity between the two charts as would amount to an appropriation of the plaintiff's independent work. The ideas are similar, but the expressions are not substantially so.

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5. For a discussion of infringement of copyrighted drawings in a more "artistic" setting, *see* the opinion of Judge Campbell in Esquire, Inc. v. Varga Enterprises, Inc., 81 F.Supp. 306 (N.D.Ill. 1948), *modified* 185 F.2d 14 (7rh Cir. 1950).

6. Universal also filed a suit for a patent infringement of the training machine itself, but that case is not before us here.

Our finding that there is no infringement requires that the contempt citation also be set aside.7 The proceeding here was for civil, not criminal, contempt--a distinction which is most important. A defendant may be punished for criminal contempt for failing to obey an injunction which is later set aside, *United States v. United Mine Workers,* 330 U.S. 258 (1947), but the same result does not follow in a civil contempt proceeding.

The difference in treatment is due to the nature of the civil contempt proceeding. It is not designed to vindicate the court's authority but to recompense one of the private parties for loss caused by the failure of the other to observe the court's order. The civil contempt order is strictly remedial. As the Supreme Court said in *United States v. United Mine Workers, supra,* "[T]he right to remedial relief falls with injunction which events prove was erroneously issued..." A vacation of the injunction establishes that there was no basis for any claim for loss based on the invalid court order. *See Salvage Process Corp. v. Acme Tank Cleaning Process Corp.,* 86 F.2d 727 (2d Cir. 1936). *See also Worden v. Searls,* 121 U.S. 14 (1887). Accordingly, the

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7. The defendants have appealed from the finding of contempt as well as the summary judgment establishing infringement. In view of our disposition of the issues, we need not decide whether the mailings that occurred before the posting of the bond violated the preliminary injunction.

judgment of the court below as to appellants will be vacated, as are the findings and judgment of contempt. Judgment will be entered in favor of the appellants.[8] Costs to be taxed against appellee.

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8. Since the defendant Salkeld did not appeal, the judgments against him will not be affected by this opinion.

A True Copy:

Teste:

*Clerk of the United States Court of Appeals for the Third Circuit*

Judgment of the United States Court of Appeals

UNITED STATES COURT OF APPEALS
For The Third Circuit

[Caption Omitted]

ON APPEAL FROM THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

Present: Aldisert, Weis and Garth, Circuit Judges

JUDGMENT

This cause came on to be heard on the record from the United States District Court for the Western District of Pennsylvania and was argued by counsel.

On consideration whereof, it is now here ordered and adjudged by this Court that the judgment of the said District Court, filed March 11, 1974, be, and the same is hereby vacated as to appellants, as are the findings and judgment of contempt, filed March 4, 1974. It is further ordered and adjudged by this Court judgment be, and the same is hereby entered in favor of appellants. Costs taxed against appellee.

ATTEST:

Clerk

February 28, 1975

Opinion of the United States Court of Appeals

UNITED STATES COURT OF APPEALS
For The Third Circuit

[Caption Omitted]

SUR PETITION FOR REHEARING

Present: SEITZ, Chief Judge, VAN DUSEN, ALDISERT ADAMS, GIBBONS, ROSENN, HUNTER, WEIS and GARTH, Circuit Judges.

The petition for rehearing filed by Appellee, UNIVERSAL ATHLETIC SALES CO., a corporation, in the above entitled case having been submitted to the judges who participated in the decision of this court and to all the other available circuit judges of the circuit in regular active service, and no judge who concurred in the decision having asked for rehearing, and a majority of the circuit judges of the circuit in regular active service not having voted for rehearing by the court in banc, the petition for rehearing is denied.

By the Court,

_____
Judge

Dated: APRIL 7, 1975

Opinion Of The United States District Court
For The Western District Of Pennsylvania

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

| | | |
|---|---|---|
| UNIVERSAL ATHLETIC SALES COMPANY | ) | |
| V. | ) | CIVIL ACTION NO. 71-1113 |
| LARRY SALKELD, DONALD E. PINCHOCK, S. DAVID BRODSKY d/b/a SUPER ATHLETICS CORPORATION; WES HUDSON and SUPER ATHLETICS CORPORATION | ) | |

OPINION AND ORDER GRANTING
PRELIMINARY INJUNCTION

KNOX, District Judge

This is an action for copyright infringement claiming that the defendants have copied and are using for commercial purposes certain wall charts and coachs' training manuals copyrighted by plaintiff illustrating the use of plaintiff's gymnasium exercising equipment. There is a companion case pending in this court involving patent infringement and unfair competition in connection with the manufacture and sale of equipment at Civil Action No. 71-166. Plaintiff has filed a Motion for Preliminary Injunction to restrain defendants from use of the allegedly pirated wall charts and training manuals pending final determination of the litigation.

Attached to the motion was a comprehensive appendix with affidavits, comparison charts,

excerpts from depositions and copies of the defendants' brochures. The matter was fixed for hearing and argument before the undersigned on March 22, 1972. Defendants filed no answer to the allegations of the motion although they did file a brief with respect to the matter and have since filed an affidavit by defendant Salkeld. Neither plaintiff nor defendants presented any evidence at the time of the hearing. While defendants in their answer to the complaint denied that the copyrights claimed by the plaintiff were in existence, no evidence to support this allegation has been produced and from the brief it appears that defendants are apparently trying to contend that the copyright covers material which is not original.

There appears to be no question that plaintiff possesses copyrights covering this material being Copyright No. A251677 publication dated July 30, 1969, Copyright No. A252280 publication dated July 30, 1970, and Copyright A139968 publication dated February 15, 1970, covering the training manual.

In passing upon a motion for preliminary injunction in such a case, we are to consider the following factors:

(1) Ownership of copyright.

(2) Copying of the copyright material by the defendants which in turn leads to two inquiries:

(a) Is there substantial similarity?

(b) Did the defendant have access to the material?

(3) Likelihood of plaintiff's success on the merits -- has plaintiff made out a prima facie case for relief?

(4) Irreparable injuries to the plaintiff if preliminary injunction is not issued.

(5) Comparative hardship to the defendant resulting from the issuance of the preliminary injunction. See McGraw Hill Inc. v. Worth Publishers Inc., 335 F.S. 415 (S.D.N.Y. 1971) cited by defendants in their brief.

(1) Ownership of the copyright. No evidence has been introduced to combat the prima facie evidence of ownership of these copyrights in the plaintiff. While defendants claim that there was a prior wall chart of Marcy Gymnasium Equipment Company dated January 1970, there has been no evidence of this as plaintiff points out the date of publication in the first copyright No. A251677 is July 30, 1969.

(2) Copying by defendants.

(a) Substantial similarity. The court has carefully studied the figures on the wall charts in plaintiff's copyrighted work and the figures contained in defendants' wall charts. The test to be applied is whether there is substantial similarity between the two works and whether "an average lay observer would find a substantial similarity in the designs recognizing the copy to be an appropriation of the copyrighted work". Concord Fabrics Inc. v. Marcus Brothers Textile Corp. 409 F 2d 1315 (2d cir 1969). There the court further said:

> "While there are some differences in both the color and design of the two patterns, we think that the average observer would probably find them substantially similar. In our view the plaintiff is likely to succeed after trial. It seems clear to us that in its discretion, the district court should have granted a preliminary injunction."

Viewing the charts from this standpoint, we readily agree with plaintiff that much of defendants' work was copied from plaintiff's copyrighted work and many of the figures are obviously a mirror image of plaintiff's figures. Many of the figures on each chart are in the same position but where plaintiff's figure faces to the right, the corresponding figure in defendants' chart faces to the left. While this might reduce the chance of obvious similarity being apparent at a first glance and therefore this method may have been used for this purpose, nevertheless a study of the figures convinces us that there is substantial similarity. Other similarities are pointed out in plaintiff's brief on page 7 and the court finds them to be true. We particularly note the positions of the various arms and legs where the exerciser is not at the moment using that member and the position is immaterial. Such examples are the left leg in figures 3F (plaintiff's work) and 3f (defendant's work); also the position of the left arm in 5J and 5j; again the position of the left arm in the shotput exercise 5V and 5v. In row 9, the figures are all similar and so is the frame-like structure shown in line 12. Another obvious example is the position of the right arm in 5N as compared with 5n. There are also substantial similarities in the coachs' manual.

(b) Access. If defendants had had no access to plaintiff's work, the argument of "mere coincidence" might be used. While defendants in their affidavit do deny actual copying nevertheless the Isenburg and Peters affidavits submitted with the motion demonstrate that Salkeld did see these wall charts and they were last seen when he was looking at them and thereafter could not be found. In Salkeld's depositions at page 260, he admits seeing copies of the coachs' manual at Hampton Highschool. At page 262, he admits seeing the coachs' manual and at page 263 he says "they sent them in to us (referring to friends in the coaching field) and it is very obvious that this was given to us by someone." At pages 418-422, he admits giving the sketches for the figures to the artist admitting he gave the artist stick sketches with stick figures. A reasonable opportunity to view the copyrighted work is regarded as access in itself. Blazon Inc. v. DeLuxe Game Corp., 268 F.S. 416 (S.D.N.Y. 1965).

(3) Likelihood of success on the merits. The court concludes that plaintiff has made out a prima facie case for relief and is likely to succeed on the merits. We must remember that a copyright gives protection to expression of an idea not the idea itself. A copyright protects originality rather than novelty or invention and confers "the sole right of multiplying copies". The copyright law is "intended definitely to grant value enforceable rights to authors, publishers, etc. without burdensome requirements". Mazer v. Stein, 347 US 201, 98 L ed 630, 74 S Ct 460 (1954).

Where copyright materials are used in substantial quantity, no detailed showing or irreparable harm is needed. Even if parts of the work are original this does not allow the defendants to incorporate copyrighted materials belonging to the plaintiff. Douglas International Corp. v. Baker, 335 FS 282 (S.D.N.Y. 1971).

(4) Irreparable harm to plaintiff. The evidence of irreparable harm to plaintiff is not strong and this problem has given us some trouble. The weight of authority, particularly in the Southern District of New York, which apparently has a large mass of copyright litigation, is that where there is a prima facie case of infringement there need not be a detailed showing of irreparable harm. See Douglas International Corp. supra; Rice v. American Program Bureau, 335 FS 124 (S.D.N.Y. 1971); Herbert Rosenthal Jewelry Corp. v. Zale Corp., 323 FS 1234 (S.D.N.Y. 1971). The latter case holds that the fact that defendants' activities if continued could adversely affect plaintiff's position as a competitor justifies a preliminary injunction and that less proof is required in a copyright case than in the ordinary case of preliminary injunction. As a matter of fact, the Second Circuit in Concord Fabrics Inc. supra simply said: "that an injunction pending the outcome of trial in such a case should issue if plaintiff can show a reasonable probability of prevailing on the merits."

In the instant case, aside from the claimed possibility of defendant's insolvency or transfer of assets, the evidence indicates that these exercise machines are of such a nature as to require wall charts and manuals for their proper use although it is obvious that the machines could be used without such materials.

We have given close attention to the case of Kontes Glass Co. v. Lab Glass Inc., 373 F 2d 219 (3d cir 1967 - opinion by Judge Freedman). In that case the court held that the plaintiff had made no showing of irreparable injury which is an essential prerequisite to a preliminary injunction. The court also held however that there was no reasonable likelihood that plaintiff would succeed on the merits. In the instant case we conclude that plaintiff has a strong likelihood of succeeding on the merits and there has been some showing or irreparable harm. We conclude that Kontes Glass supra did not intend to establish a rule that in copyright cases irreparable harm must be shown with the same detail as in other cases <u>if there is</u> a strong likelihood of plaintiff's success on the merits. Kontes does not specify the strength of showing of irreparable harm.

(5) Hardship to defendants. Defendants have shown no particular hardship to them which might result from a preliminary injunction. While paragraph 23 of defendants' brochure (tab 10 of plaintiff's appendix to motion for preliminary injunction) does state that exercise wall charts and coachs' training material are supplied at no additional charge nevertheless Salkeld's affidavit page 3 paragraph 6 indicates he will not be substantially interfered with:

> "Prior to the time that I attempted to sell gym training machines with a wall chart in the early part of 1971, I had sold, either personally or

> through corporations with which I was associated, at least 400 gym training machines in competition with the plaintiff, which machines were sold without a wall chart. This, in my opinion, indicates that the wall chart, while perhaps desirable, is a minor factor in inducing customers to purchase gym training machines."

For the above reasons, we conclude that all the requirements for a preliminary injunction have been met. This memorandum of decision shall be considered as containing the findings of fact and conclusions of law by the court and the reasons for the issuance of a preliminary injunction as required by Rule 65(d) and Rule 52(a). An appropriate order will be entered.

ORDER

AND NOW, to wit, April 13, 1972, upon consideration of plaintiff's Motion for Preliminary Injunction and after a hearing on the same and for the reasons set forth in the foregoing memorandum,

IT IS ORDERED that defendants Larry Salkeld, Donald E. Pinchock, S. David Brodsky and Wes Hudson, individuals, and Super Athletics Corporation, a corporation, their agents, servants, employees and all persons in active concert or participation with them are enjoined, pending a final disposition on the merits, from copying, reproducing, distributing plaintiff's wall charts or otherwise infringing plaintiff's copyrighted instructional material; namely:

(i) "Universal Gym Machine Exercise Chart", copyright 1969;

(ii) "Universal Gym Machine Exercise Chart", copyright 1970; and

(iii) "Coaches Training Manual", copyright 1970.

Bond is required in the amount of $5,000 pursuant to Rule 65(c) to be approved by the court prior to the actual issuance of the preliminary injunction.

## Opinion Of The United States District Court For The Western District Of Pennsylvania

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

[Caption Omitted]

ORDER MODIFYING ORDER GRANTING
PRELIMINARY INJUNCTION

AND NOW, to wit, April 20, 1972, IT IS ORDERED that the Order dated April 13, 1972, is modified as follows beginning at line 10 of the order:

"copying, reproducing, distributing defendants' wall charts specifically Exhibit G attached to the complaint or other material infringing on plaintiff's copyrighted material or otherwise infringing plaintiff's copyrighted instructional material, namely:"

Opinion Of The United States District Court
For The Western District Of Pennsylvania

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

[Caption Omitted]

MEMORANDUM AND ORDER HOLDING DEFENDANTS SUPER ATHLETICS CORPORATION AND S. DAVID BRODSKY IN CIVIL CONTEMPT

On April 13, 1972, this court issued a preliminary injunction holding that certain wall charts circulated by the defendant in connection with the sales of its gymnasium exercise equipment were in violation of plaintiff's copyright on such charts.1/ Matters concerning the equipment itself and patents with respect thereto are the subject of a separate suit at Civil Action No. 71-166. There is presently before the court a petition to hold two defendants in contempt for violation of the injunction.

The preliminary injunction was conditioned upon plaintiff's giving bond in the sum of $5,000. The bond in question was presented to the Clerk's Office of this court on April 21, 1972, at approximately 3:30 p.m., a Friday, when this member of the court had

1/ For complete copy of the preliminary injunction, see Appendix I attached to this order.

left for Erie to transact business at the Erie Federal Courthouse. As a result, the bond itself was not approved by the court until Monday morning April 24, 1972.

The testimony with respect to the alleged contempt is conflicting and contradictory, although two violations of the injunction involving distribution of the wall charts after the injunction was issued are rather clearly proved. One of these was admitted by the defendants and the other proved by testimony of an impartial witness which the court finds credible. Plaintiffs in addition contend that, based upon the testimony of defendant Larry Salkeld, approximately four to five hundred other wall charts were distributed to dealers and customers following the entry of the order for preliminary injunction on April 13, 1972. The defendants, on the other hand, admit only one such mailing of a wall chart and dispute even the other one, a distribution to a high school in the vicinity of Rochester, New York on April 21, 1972.

One legal question has caused the court some trouble, that is, the question of the effective date of this injunction. Can defendants be held in contempt for any violations or distributions of the wall charts which occurred prior to April 24, 1972, when the bond accompanying the injunction was approved?

It is obvious under Rule 65 of the Federal Rules of Civil Procedure that the bond was a necessary condition for the issuance of the injunction and on the face of things one would consider that the injunction was not effective until its terms were complied with, that is the

bond was filed and approved and that the defendants could not be held in contempt for any violations which occurred before that date. (See CJS Injunctions, page 928).

It is, however, also the rule that any violations after actual notice of an injunction justify holding a party for civil contempt regardless of the want of service. It is immaterial how a party acquires information as to the existence of the injunction. A party having knowledge of the same who deliberately violates it, although it has not yet been formally issued or served, is liable for contempt. See Radio Corp. of Amer. v. Cable Radio Tube Corp., 66 F 2d 778 (2d cir 1933); See also U.S. v. Onan, 190 F 2d 1 (8th cir 1951).

It is clear that this must be the rule because otherwise there would be races against the law to engage in as many violations of the injunction as possible before the marshal arrives with the papers for service. In this case, it is admitted that as soon as the injunction was ordered to be issued on April 13, 1972, defendants' counsel, Mr. Murray, having received a copy of the court order, immediately called the officers of defendant Super Athletics Corporation, Salkeld and Brodsky, and informed them of the issuance of the injunction (See page 12 of 8/23/73 and testimony of Salkeld 556). We therefore find that any violations of the court order after April 13, 1972, would subject the defendants to liability for civil contempt since they had actual notice of the same on that date.

The court is not convinced of the total credibility of any of the witnesses who have testified in connection with this contempt proceeding. It is noted originally defendant Brodsky stated under oath dated August 1, 1972, in answer to interrogatory 1.53 in Civil Action No. 71-166 that no wall charts had been supplied after April 13, 1972, to any customers or dealers although previously they went with each machine. See plaintiff's contempt Exhibit 3. See also revised answers of August 31, 1972. On the other hand, it was later admitted by Mr. Brodsky on June 28, 1973, that a wall chart was distributed to Green High School at Uniontown, Ohio, in May or June 1972 (Brodsky 481).

In addition to this, we find that the testimony of Mr. Walzer, Football Coach at Greece Olympia High School, near Rochester, New York, as to receipt of a wall chart from defendants' agents at the time of delivery of a machine to the highschool on April 21, 1972, is also true, he being an impartial and disinterested witness. (See Walzer's deposition, page 42).

Aside from this, while we are not impressed as the result of observation and the circumstances with the total credibility of defendant Salkeld, he having been discharged as President of Super Athletics on April 24, 1972, and being at odds with defense counsel, nevertheless, we find that there is considerable truth in his testimony. (See Salkeld depositions, pages 554-561). It appears that 2,000 of these wall charts had been printed, (see answer to interrogatory 1.5) and 800 to 1000 of these remained at the Super Athletics Office. He claims that the secretary was aware thay they were on the premises and stored there. The whereabouts and distribution of this

quantity of wall charts has never been satisfactorily accounted for by the defendants. It is inconceivable that this number would just disappear. Allowing for sales and copies to three distributors not over 150 would have been used up prior to April 13, 1972. If these wall charts were still there, it would be simple to produce them in court or allow inspection of them by plaintiff's attorneys. If they were destroyed, proof of their destruction should have been offered but instead the record is silent as to what happened to them and whether they are still in existance.

We find in this a partial corroboration of Salkeld's statement that a quantity of them were mailed out after the issuance of the injunction in an attempt to beat the service of the court order and to place them in the hands of every possible prospect, one was mailed out with each machine sold and that large quantities of between 10 to 25 per dealer were placed in the hands of dealers so that they could ignorantly pass them out to prospects or customers. But there were only three dealers.

As a result of the above, the court has had great difficulty in making a determination. Salkeld himself is not certain whether 400 or 500 were mailed out. As stated, the court is not impressed with his total credibility. Considering all the circumstances, bearing in mind the burden of proof resting on plaintiff and reducing all the claims to the minimum that have been proved, it is the court's conclusion at least thirty were mailed out or otherwise distributed which were damaging to the plaintiffs. This

calculation is based largely on the list attached to revised answers to plaintiff's interrogatory 1.53 which shows twenty two machines were sold in the period April 13 through July 1, 1972. The new super trainer charts of defendant Super Athletics were received some time in July 1972 according to Carleo and some time in September according to Conn. We will take Carleo at his minimum word that thirty to fifty were sold in the interval between the injunction and receipt of the new charts.

We note that Salkeld was discharged as President of Super Athletics on April 24 and would therefore only know about the actual number of mailings between April 12 and 24. He says, however, that they were being mailed out up until the day he left. Defendant Brodsky claims that none were mailed but for reasons above set forth, we discount his testimony. Mrs. Humbert, the secretary of defendant and employee, of course, has an obvious interest in the case and for this reason, we discount her testimony as to lack of knowledge of these mailings.

We bear in mind that plaintiff has the burden of proof by clear and convincing evidence of showing just what contempt has occurred. Benner v. Philadelphia Musical Society, 233 FS 108 (E.D.Pa. 1964); Hart, Schaffner & Marx v. Alexanders Department Stores, 431 F 2d 101 (2d cir 1965).

> "A heavy burden of proof rests upon a party urging contempt to show the facts establishing the contempt by clear and convincing evidence." 233 FS 111.

On the other hand, considering all the evidence in the case, we think the evidence at a minimum shows that approximately thirty wall charts were mailed out or distributed with machines. The whereabouts of the balance has not been satisfactorily explained.

The law is clear that in finding a defendant to be in civil contempt of an injunction or restraining order issued by the court, the court's powers are remedial and are limited either (a) to compulsion to compel compliance with the injunction or (b) to award compensation and damages to the injured party. See McComb v. Jacksonville Paper Co., 336 US 187, 93 L ed 599, 69 S Ct 497 (1949) (holding wilfulness is not an element); Franklin Mint Corp. v. Franklin Mint, Ltd. 331 FS 827 (E.D.Pa. 1973). In this case, there is no need at this time to compel the defendants to do any affirmative act and therefore the court is limited to compensation. The federal courts have inherent power to enforce compliance with their lawful orders through civil contempt and it is essential that their mandates be obeyed. U.S. v. United Mine Workers, 330 US 258, 71 L ed 884, 67 S Ct 677 (1947).

In awarding compensation to plaintiff, the injured party, there are two items to be considered.

(1) Compensation for actual damages sustained as the result of issuance of these wall charts.

This as stated involves a different evaluation. It appears that the wall charts them-

selves were sold for only $4.50 each. On the other hand, they were considered an essential part of machines which were sold at sales prices varying from $2295 to $2645 each. The evidence indicates that the customers did not want the machines without the wall charts which are a valuable part of the transaction yet the charts are obviously not equal to the total value of the machine. (See testimony of Mr. Brodsky, page 481). We had expert testimony by Mr. Farrell, a distributor on Long Island, New York, who was engaged in selling such machines and he gave us his opinion as to how much of the value of the machine was represented by the wall chart. We accept this testimony as true and find that the value of each wall chart was $100.00. This we find to be the damages sustained by plaintiffs resulting from issuance of these wall charts in violation of the injunction and resulting interference with plaintiff's sales.

In view of the finding that thirty wall charts were distributed in violation of the preliminary injunction, the defendant will be fined $3000 for civil contempt to be paid to plaintiff as compensation for violation of the court's order.

(2) In addition to the actual damages suffered, plaintiff is entitled to reimbursement for reasonable counsel fees and expenses actually incurred in prosecuting this contempt.

At the threshold of this branch of the litigation now before us, we are met with a contention by the defendants that expenses of investigation in preparing the contempt proceedings should not be allowed. The plaintiff's counsel has filed a bill of costs and expenses including attorney's

fees which they claim were incurred by reason of the defendant's contempt of court. In this are included items such as preparation for depositions, making of phone calls to various schools as to possible receipt of the accused wall charts and interview of witnesses in preparation for affidavits and hearings, all this in addition to the charge for filing the proceedings themselves and attendance at court during the hearings.

Defendant contends that if an allowance is to be made for counsel fees and expenses, then no allowance can be made for so-called "investigation charges". Reliance is placed upon the case of Leman v. Krentler-Arnold Co., 284 US 448 (1932), affirming Krentler-Arnold Hinge Last Co. v. Leman, 50 F 2d 699 (CCA 1st 1931). The Supreme Court reversed the Circuit in this case for disallowing profits secured by the wrongdoer in a patent infringement case and directed that such profits may be recovered by the person whose patent has been infringed by acts of contempt. In the Circuit opinion, however, certain expenses were disallowed and also these profits. As this court understands the Supreme Court opinion, the Circuit was reversed only as to the disallowance of profits and the disallowance of the other items was affirmed. However, on examining the Circuit Court opinion, it appears that when expenses for investigation were referred to, this was an investigation as to the possible liability of another party and not the liability of the defendant itself which was found to be in contempt. The opinion contains significant language that such expenses "should be confined to expenses incurred and legal services rendered in <u>these</u> contempt proceedings and to such as were reasonably necessary".

Applying that to this case, it is readily apparent that investigation was needed in order to determine what witnesses should be called, what affidavits secured and what were the facts that could be developed with respect to the alleged contempt of passing out the accused wall charts after the date on which the injunction was ordered, viz: April 13, 1972. Certainly, expenses of investigation as to the defendant itself were necessary as part of these proceedings. The attorney in every law suit has to examine witnesses and prepare his case so as to make a proper presentation at the hearing. Certainly, such investigation expenses and counsel fees for the time spent thereon are a necessary part of the proceedings. Such expenses are recognized under the Criminal Justice Act as an allowance for defense of criminal defendants and we see no reason why they should not be allowed as necessary expenses in connection with this contempt proceeding. We will therefore allow them.

It will be noted, however, that only expenses such as are reasonably necessary for the services rendered in these proceedings are to be allowed and they should only be allowed in a modest amount so as to provide reasonable compensation only. We have approached the problem of determining the amount in this light.

It is the court's conclusion that at no time were the services of two attorneys required and that therefore the expenses of Mr. Dalgarn's trips from California (he being the general counsel for the plaintiff company) to Pittsburgh and also other expenses such as telephone calls to California, and so forth, should be disallowed. Mr. Yeager, the local counsel for plaintiff, is a thoroughly competent and experienced Pittsburgh lawyer and ably conducted most of the investigation in this case and the contempt hearings

themselves. For this reason, we have disallowed the expenses in connection with Mr. Dalgarn's appearance in the proceedings as not a proper item to be collected from the defendants.

We have been greatly troubled as to the valuation to be put on Mr. Yeager's time. There is no question that he is a leading member of the bar in Allegheny County and a charge of $50.00 per hour in this day and age may be considered a reasonable customary charge for lawyers of his professional standing to make to clients considering the demands upon their time and their standing in the profession. When we approach a problem such as this, however, of imposing these charges upon the opposing party in a law suit, the court is bound to consider only a reduced fair charge under the circumstances. We have therefore determined in the light of these discussions to allow expenses only in the amount of $1,950.69 and attorney's fees for Mr. Yeager only for 81.25 hours at $35.00 per hour or a total of $2,843.75 for fees. This makes a total allowance for counsel fees and expenses of $4,794.44.

The court has allowed nothing for proceedings in connection with the attempt to disqualify defendant's attorneys included in Division 2 of the plaintiff's bill of costs. The court has been unable to determine how the attempted disqualification of defendant's counsel bore on the contempt proceeding. The motion for contempt was filed October 6, 1972 and the motion to disqualify November 1, 1972.

The filing of the latter threw the case into confusion until it was determined and nothing further could proceed until it was finally decided that defense counsel were not to be disqualified at least for the time being. The court reserved the right to disqualify in the future if breach of confidential matters should later appear.

We are following the admonition laid down by the First Circuit in the Leman case and limiting the allowance of counsel fees and expenses to these proceedings only and not to other proceedings in this case.

Appendix II shows in detail the items allowed.

The foregoing contains findings of fact in accordance with Rule 52(a).

## CONCLUSIONS OF LAW

1. The defendants, S. David Brodsky and Super Athletics Corporation, a corporation, have been in contempt of the order of this court entered April 13, 1972, in distributing wall charts in violation thereof.

2. This contempt is a civil contempt only.

3. The defendants should be required to pay a fine as compensation to the plaintiff made up of the following items:

| | | |
|---|---|---|
| (a) | Damages to plaintiff resulting from distribution of the accused wall chart, 30 at $100 each | $3,000.00 |
| (b) | Counsel fees and expenses | $4,794.44 |
| | Total | $7,794.44 |

An appropriate order will be entered.

ORDER

AND NOW, to wit, February 28, 1974, after consideration of the briefs and arguments of counsel and after hearing all the evidence in this matter and for reasons set forth in the foregoing memorandum,

IT IS ORDERED that the defendants, David Brodsky and Super Athletics Corporation, a corporation, be adjudged in contempt of this court for violation of the preliminary injunction issued April 13, 1972.

IT IS FURTHER ORDERED that said defendants shall pay a fine to the plaintiff in this case as compensation to the plaintiff for violation of said injunction in the amount of $7,794.44.

IT IS FURTHER ORDERED that said defendants shall pay the costs of this contempt proceeding.

[APPENDICES OMITTED]

## Opinion Of The United States District Court For The Western District Of Pennsylvania

IN THE UNITED STATES DISTRICT COURT
FOR THE WESTERN DISTRICT OF PENNSYLVANIA

[Caption Omitted]

MEMORANDUM AND ORDER GRANTING
PLAINTIFF'S MOTION FOR SUMMARY JUDGMENT

In this copyright infringement case the plaintiff, owner of the copyright, has sought a summary judgment against the defendant. It is claimed that the defendants copied and were using for commercial purposes certain wall charts and coach's training manuals copyrighted by the plaintiff which illustrate the use of plaintiff's gymnasium exercising equipment. This gymnasium equipment is a subject of a separate suit for patent infringement at Civil Action No. 71-166 and is also involved in a consolidated case at Civil Action No. 72-1107. We have determined that there is no genuine issue of material fact involved in this case and pursuant to Rule 56(c), plaintiff is entitled to judgment as a matter of law.

Previously, on April 13, 1972, this court filed a memorandum and order granting a preliminary injunction against the use of the copyrighted materials by the defendants1/ and on March 4, 1974, we have adjudicated the defendants Brodsky and Super Athletics Corporation in contempt for

1/ See Universal Athletic Sales Co. v. Salkeld, et al, 340 FS 899 (W.D.Pa. 1972).

violation of the preliminary injunction restraining them from distributing the copyrighted materials. The case has been delayed by proceedings brought by plaintiff to disqualify defendants' counsel.

The preliminary injunction was granted on the basis that there was no substantial dispute as to the ownership of the copyright, that there had been copying by the defendants based on substantial similarity between the figures on the plaintiff's copyrighted wall charts and the figures contained in defendant's wall charts developed for use with defendants' gymnasium equipment and that the evidence indicated access by the defendants to plaintiff's work. The court further held that plaintiffs were likely to succeed upon the merits, that the irreparable harm to the plaintiffs had been shown as sufficient for a copyright case and that no particular hardship would result from the issuance of a preliminary injunction. Therefore the order was issued.

For the purposes of the present opinion, we will not repeat what was said in the opinion and order granting the preliminary injunction but will incorporate the same by reference herein for the purpose of showing the facts as found by the court and the authorities relied upon for the decision there made.

Since then the parties have taken extensive depositions and the findings as made in the preliminary injunction have been reinforced by what has developed during the course of this litigation.

Again, we state there is no substantial question as to the ownership of the patent since the requests for admissions were served upon defendants on July 13, 1973, in which defendants were requested to admit that the plaintiff was the owner of the copyrights in question A251677, A252280, A139968 and that the same were valid. Defendant did not reply to these requests for admission within 30 days as required by Rule 36(a) and therefore these matters will be considered admitted. It is elementary that the copyright is presumed valid unless shown to the contrary.

As stated, when the preliminary injunction was handed down, all the court had to go on was finding of substantial similarity in comparing the two wall charts side by side and also finding that the defendant Salkeld, formerly President of defendant Super Athletics Corporation, had had access to the plaintiff's wall chart and therefore copying could be inferred. See Concord Fabrics v. Marcus Brothers Textile Corp., 409 F 2d 1315 (2d cir 1969); Blazon, Inc. v. Deluxe Game Corp., 268 FS 416 (S.D.N.Y. 1965).

The evidence as developed on depositions particularly those of defendant Salkeld and defendant Wesley A. Hutsenpillar (generally referred to in the depositions and pleadings and in this memorandum as "Wes Hudson") indicates that Salkeld (pages 595 and 596) had instructed Hudson to make a wall chart for the defendant Super Athletics Corporation and saw that it came from a "glue up" of plaintiff's wall chart which would be a method of reproducing the same.

Defendants claim that there is an issue of material fact with respect to the credibility of

Salkeld's testimony. In his first depositions taken prior to the issuance of the preliminary injunction, his testimony was ambiguous with respect to access and copying. However, in his second depositions, he admits that Hudson had a copy of plaintiff's wall chart and was engaged in copying therefrom. Hudson himself admitted (page 106-111 of depositions) that he copied plaintiff's chart by having it placed in front of him and making freehand drawings from the same. It is true that Hudson many times in his depositions denied having traced the accused wall chart from plaintiff's copyrighted work. But in the view of the court it makes no difference whether it was copied by freehand copying or by tracing. Therefore any dispute between Salkeld and Hudson as to the method by which defendant's wall chart was prepared would not be a dispute of a material fact because in the court's view it makes no difference whether the same was copied by freehand or by tracing. Many persons are skilled in copying works of art and signatures of others by freehand drawing and how this would make any difference when there is evidence of actual copying is not apparent. It is certainly not important in raising any genuine issue of material fact. It is noted that 2,000 of these wall charts were printed by the printer in the year 1971.

In Nimmer, the Law of Copyright (1972) Ed §141.2, page 613, it is said: "It is generally not possible to establish copying by direct evidence since it is rare that the plaintiff has available a witness to the act of copying. Apart from the unavailability of witnesses, copying may occur without any objective physical manifestation since copying from

memory is no less actionable than his copying from direct view." See Edwards & Deutsch Lithographing Co. v. Boorman, 15 F 2d 35 (CCA 7th 1926); Frendenthal v. Hebrew Pub Co. 44 FS 754 (S.D.N.Y. 1942); Whitney v. Ross Jungnickel, Inc. 179 FS 751 (S.D.N.Y. 1960).

Since there is no genuine issue of material fact to be tried, plaintiffs are entitled to a summary judgment.

In 18 Am Jur 2d, copyright and literary property §104, page 392, it is stated:

> "Infringement involves a copying, in whole or in part, either in haec verba or by colorable variation. The copyrighting of an illustration merely precludes another from copying it, not from making his own. When a basic design is in public domain, the owner of a copyright on the design is entitled to relief only if the defendant copies its 'expression'. Without copying, there can be no infringement of copyright. A 'copy', as used in copyright cases, signifies a tangible object which is a reproduction of the original work. The question is not whether the alleged infringer could have obtained the same information by going to the same source and do his own independent research. In other words, the test is whether one charged with the infringement made on independent production, or made a substantial and unfair use of the plaintiff's work. The unlawful use of imported works so as to violate the rights of the proprietor of the American copyright or annul

or limit the protection secured to him is deemed an infringement."

ORDER

AND NOW, to wit, March 11, 1974, upon consideration of plaintif's motion for summary judgment of copyright infringement including all matters made of record in connection therewith and after a hearing upon said motion, it is

ORDERED, ADJUDGED AND DECREED as follows:

(a) that plaintiff is entitled to judgment against defendants on the issue of copyright infringement;

(b) that defendants shall account for profits and damages under 17 U.S.C. 101(b) for the aforesaid copyright infringement and that plaintiff be awarded punitive damages;

(c) that defendants, their agents, servants, employees, and all persons in active concert or participation with them are permanently enjoined from further copyright infringement under 17 U.S.C. 101(a);

(d) that defendants are required to deliver up under oath for destruction pursuant to 17 U.S.C. 101(d) any and all wall charts or other instructional material in their possession or control having a substantial similarity to plaintiff's copyrighted wall charts and coaches training manual, as well as all plates or other means for making such infringing copies; and

(e) that plaintiff is awarded full costs including reasonable attorney fees under 17 U.S.C. 116.

(f) a hearing to determine the amounts, if any, to be awarded plaintiff under paragraphs (b) and (e) hereof shall be held Wednesday, March 27, 1974, at 1:30 p.m.